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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/072,873	02/12/2002	Paolo Cuzzato	108910-00052	2426

7590 03/26/2003

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EXAMINER

VOLLANO, JEAN F

ART UNIT PAPER NUMBER

1621

DATE MAILED: 03/26/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/072,873

Applicant(s)

CUZZATO ET AL

Examiner

Jean F. Vollano

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-- Th MAILING DATE of this communication app ars on th cover sheet with the correspondenc address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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### DETAILED ACTION

1. The RCE filed 12/12/ 2003 has been entered. Claims 1-6 are pending.
2. The amendment to consisting of an aluminum fluoride in a fixed or fluidized bed has overcome the 35 U.S.C. 103 rejection over Miller and it is withdrawn.

### *Claim Rejections - 35 U.S.C. § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Manzer et al US 5,243,106.

When Manzer et al teaches a process for the preparation of CFC113a as well as other products from the reaction of CFC113 on a catalyst consisting of aluminum fluoride which is a fixed bed catalyst.

There is no limitation that requires CFC113a to be the major product only that it must be made. The examples show that there is some CFC113a and that the catalyst consists essentially

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of aluminum fluoride. There is no exclusion as to other additives (e.g. HF) which are not catalytic in nature. The requirement is for there to be no other catalyst present except aluminum fluoride and that limitation is met.

*Claim Rejections - 35 U.S.C. § 103*

5. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manzer et al US 5,243,106.

Manzer et al teaches a process for the preparation of CFC113a as well as other products from the reaction of CFC113 on a catalyst consisting of aluminum fluoride (see abstract and examples).

Manzer et al teaches that the process of isomerizing the saturated C2 fluorohydrocarbons including CFC113 is preformed by contacting in the gaseous phase at a temperature of from about 200°C (see column 2, lines 60-65 and examples).

Manzer et al teaches that after a time there is a mixture of CFC113a and CFC113 in the reaction see examples ( there is no limitation that the mixture be an initial mixture before the reaction begins to occur).

Manzer et al teaches that the catalyst is in a fixed or fluidized bed (see the examples)

Manzer et al does not specifically teach various lower temperatures.

However it would have been obvious to one of ordinary skill in the art to have used the process of Manzer et al and to have optimized the reaction conditions (e.g. temperature and flow

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rate) to have optimized the yield. ( A change in temperature, concentration or both is normally an unpatentable modification unless the ranges claimed produce a new and unexpected result which is different in kind and not merely different in degree from the prior art. *In re Aller* , 220 F.2d 454, 105 USPQ 233, 235 (CCPA 1955).

6. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chem abs 673 (CA:113:61673).

Chem abs 673 teaches the process for preparing CFC113a starting from CFC113 in the presence of a catalyst consisting of aluminum fluoride.

Chem abs 673 teaches that after the initial reaction there is both CFC113 and CFC113a as a mixture in the reaction.

Chem abs 673 is silent as to the reaction temperatures and if the  $AlF_3$  is a fixed or fluidized bed

It would have been obvious to one of ordinary skill in the art to use the process of Chem abs 673 and to optimize the temperature to optimize the yield/purity of the desired product ( *In re Aller* -see above). It is also well within the purview of one of ordinary skill in the art to have used the two main alternative bed types (fixed or fluidized) for the instant process.

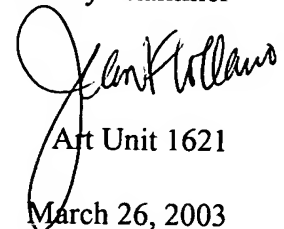
The full text of this article has been requested and will be given in the next office action.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr J F Vollano whose telephone number is (703) 305-4483. The examiner can normally be reached on Monday to Thursday from 6:30 to 5:00 .
8. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter , can be reached on (703)308-4532 . The official fax phone number for the organization where this application or proceeding is assigned is (703)308-4556. It should be noted that the examiner cannot immediately work on a fax sent to this number.
9. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1235.

Jean F. Vollano

Primary Examiner



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March 26, 2003